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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,389	06/06/2000	William F. Walsh	22830-67061	8153

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EXAMINER

CAMPEN, KELLY SCAGGS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 06/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/588,389

Applicant(s)

WALSH ET AL.

Examiner

Kelly Campen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/15/04 has been entered.

Specification

Applicant is reminded of the content of the Specification. It appears in the instant application, the "Brief Summary of the Invention" is more than twice as long as the "Detailed Description" as well as the claims are three times as long as the "Detailed Description" of the invention.

Examiner will expand upon this in the 35 USC 112 second paragraph rejection below.

Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).

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- (e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.
- Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.
- (f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
- (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements,

compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

- (j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (l) Sequence Listing: See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-19 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed method consists solely of the manipulation of an

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abstract idea and is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459. In addition, the claim is devoid of any limitation to a practical application in the technological arts. The invention in the **body** of the claim must recite technology. If the invention, in the body of the claim, is not tied to technological art, environment, or machine, the claim is not statutory (see *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001). Also note MPEP 2106 IV 2(b). Examiner notes that this is not a precedential decision but it is being cited for its analysis of whether the claim is in the technological arts.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. in claim 1, lines 5-6 “separate from said first financial institution”, claim 8, lines 6-7 “separate from said first financial institution” in claim 15, lines 5-6 “separate from said first

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financial institution” and in claim 20, lines 5-6 “separate from said first financial institution” are not supported by the disclosure and are new matter.

Claims 20-25 and 3-7, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, it is unclear what the “means for” language is directed to, if it is directed to computer code, there is none in the specification, and it appears it could also be directed to an individual doing the action. In addition, there appears to be no enablement for the menu choice system.

Claims 20-25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 20, pursuant to § 112, ¶ 6, a structure disclosed in the specification is “corresponding” structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim. *B. Braun Med., Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed. Cir. 1997). Whether the specification adequately sets forth structure corresponding to the claimed functions must be considered from the perspective of one skilled in the art. *Intel Corp. v. VIA Techs., Inc.*, 319 F.3d 1357, 1365-66 (Fed. Cir. 2003). If one fails to set forth an adequate disclosure with respect to the corresponding structure of a means-plus-function limitation, then one has failed to “particularly point out and distinctly claim the subject matter which the applicant regards as his invention,” as required by § 112, ¶ 2. *In re Donaldson Co.*, 16 F.3d 1189, 1195 (Fed. Cir. 1994) (en banc).

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Claims 4-7, 13-19, and 22-25 recites the limitation "'third'" in the claims. There is insufficient antecedent basis for this limitation in the claim.

In order for the claims to serve their proper function of providing the public clear notice of the scope of the patentee's property rights, we cannot allow a patentee to claim in functional terms essentially unbounded by any reference to what one of skill in the art would understand from the public record. The scope of a claim under section 112, paragraph 6 therefore must be limited to structures clearly linked or associated with the claimed function in the specification or prosecution history and equivalents of those structures.

The duty of a patentee to clearly link or associate structure with the claimed function is the quid pro quo for allowing the patentee to express the claim in terms of function under section 112, paragraph 6. Budde v. Harley-Davidson, Inc., 250 F.3d 1369, 1377 (Fed. Cir. 2001). Section 112, paragraph 6 was intended to allow the use of means expressions in patent claims without requiring the patentee to recite in the claims all possible structures that could be used as means in the claimed apparatus. O.I. Corp. v. Tekmar Co., 115 F.3d 1576, 1583 (Fed. Cir. 1997). However, "[t]he price that must be paid for use of that convenience is limitation of the claim to the means specified in the written description and equivalents thereof." Id. If the specification is not clear as to the structure that the patentee intends to correspond to the claimed function, then the patentee has not paid that price but is rather attempting to claim in functional terms unbounded by any reference to structure in the specification. Such is impermissible under the statute.

The requirement that a particular structure be clearly linked with the claimed function in order to qualify as corresponding structure is also supported by the requirement of 35 U.S.C. §

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112, ¶ 2 that an invention must be particularly pointed out and distinctly claimed. B. Braun, 124 F.3d at 1424-25. "The requirement that the claims 'particularly point[] out and distinctly claim[]' the invention is met when a person experienced in the field of the invention would understand the scope of the subject matter that is patented when the claim is read in conjunction with the rest of the specification." S3, Inc. v. nVIDIA Corp., 259 F.3d 1364, 1367 (Fed. Cir. 2001).

Although indefiniteness of the claims is not an issue in this case because the specification does disclose the framegrabber and CVP as corresponding structures for the function of converting images, a failure to associate software with the converting function is a failure to particularly point out and claim that particular structure as a means of performing the function.

Claim Rejections - 35 USC § 103

The prior art is being interpreted as best can be interpreted in light of the specification.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,8,15, and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over Atkins (US 5,864,828). Atkins discloses a method for creating a single financial product that combines financial elements into a single financial element through a single computer-based management facility comprising the steps of: selecting at least one first financial institution in order to establish an asset account (see col. 1, lines 16-20) "package" as single financial product that combines financial statements (see abstract) "asset account" "financial management" "financial institution" (see col. 1, lines 37-49; col. 2, lines 1-21) "programming", "computer based" (see col. 9, lines 19-33, 43-45) first institution has asset account (see fig 2 (226,224,230,246)-, fig 3(254)); selecting at least one second financial institution in order to establish a liability account (see col. 9, lines 19-33, 56-41: "Other banks" as second institutions (see col. 23, lines 13-15: second institution (see fig 3(256) and fig 2(226,224,230,246); establishing a first legal agreement with said first financial institution, (see col. 9, lines 43 to col. 8, line 7, col. 10, lines 22-48, esp. table 6, 11, lines 62 to col. 11, line 4) establishing a second legal agreement with

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said second financial institution (see col. 7, lines 56 to col. 8, line 7) (financial agreements with insurance co. as buying an asset policy with payment as a liability)(see col. 11, lines 5-24)(liability account as the mortgage)(see col. 9, lines 14-34) "Other banks...financial institution..." as a second financial institution.

Atkins teaches first legal agreement and the second legal agreement (see col. 9, lines 43 to col.8, line 7 and col. 10, lines 22-48, esp. table 6, 11, line 62 to col. 11, line 4 and col. 7, line 56 to col. 8, line 7) financial agreements with insurance company as buying an asset with payment as a liability (see col. 11, lines 5-24)(liability account as the mortgage) (see col. 9, lines 14-34) "Other banks...financial institution..." as the second financial institution.

However, Atkins does not explicitly teach an umbrella agreement. Official notice is taken, as applied in the previous office actions, that this feature is old and well known in the insurance art in the form of, for example, an umbrella insurance agreement or policy or contract. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement this feature of umbrella agreement for the advantage of lower rates and more liability coverage.

Atkins discloses wherein said asset account and said liability account are each separately and independently managed by said first and said second financial institutions, respectively (see fig 2 :26,28,52,32 and col. 32, lines 42-45). For example, first financial institution may hold a bond, a financial agreement, as an asset (investment) and the second financial institution may the bond issuer and thus the liability party. Each financial institution party is a separate entity while being linked by a common financial instrument, in this case a bond, which is an asset on one entities books and a liability on the other entities books. The bond itself is a umbrella legal agreement between bearer and issuer as to their rights and liabilities.

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Claims 2-7, 9-14, 16-19 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Atkins (US 5,864,828) and in view of Lloyd (US 4,876,648).

Specifically as to claims 2, 9, 16 and 21, Atkins discloses at least one of said first financial institution and at least one of the second financial institution (see col. 9, lines 19-33., fig 2 (224,226,246)). However, Atkins does not explicitly disclose the choice among each type of financial institutions. Lloyd teaches the choice among each type of financial institutions (see col. 25, lines 58 to col. 26, line 5 and col. 3, lines 28-30, 48-52. It would have been obvious to one of ordinary skill in the art at the time of the invention to implement this feature of choice among each type of financial institutions for the advantage of comparing opportunity costs of alternative investments with other institutions.

Specifically as to claims 3, 10, 17 and 22, Atkins discloses wherein said step of selecting said first financial institution to establish said asset account and said step of choosing said financial institution in order to establish said liability account is facilitated by a menu choice system (see col. 9, lines 19-33, 49-61) ("Other banks..." is selection option) (see also col. 12, lines 10-11, 44-46, 63-64).

Specifically as to claims 4, 11, 18 and 23, Atkins discloses wherein said menu choice system further includes creating a performance model (see fig 8A(303) to fig 10A(618); col 19, lines 51 to col 20, line 25; col 21 , lines 5- 33.

Specifically as to claims 5, 12 and 19, Atkins discloses wherein said menu choice system further comprises a step for establishing a reporting facility (see fig 5(208-216) and 6(402,452): col. 21, lines 34-41.

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Specifically as to claims 6, 13 and 24, Atkins discloses said financial product further comprises: a third legal agreement between the first financial institution and the second financial institution to combine at least one asset account with at least one mortgage account (see col. 19, lines 19-33, 46-55(asset account); col 9, lines 56-61(mortgage liability account) col 10, table 6, 11: (HOPE Mortgage Master Agreement third agreement)) the umbrella agreement comprising a cash flow pass through agreement with the second financial institution and a synthetic structured loan that is based on principal amortization obligation with the lending institution, and abstract: "Client funds....alternatively be used to increase the value of a designated asset account.", where funds are cash flow mortgage payments (see col 5, lines 33-40 (cash flow mortgage payments) col 7, lines 59 to col 8, line 7 (received outside of framework of HOPE asset)) a customer level performance distribution agreement with said first financial institution (see col 2, lines 15-21) (first financial institution can be one with HOPE software package (col 4, lines 1-8) (reporting on investment).

Specifically as to claims 7, 14 and 25, Atkins discloses a financial product further comprising a customer level account maintained by a third party facility encompassing a collateral agreement creating additional cash-flows from said second financial institution and a customer level cash flow transfer and servicing agreement with said first financial institution (col 2, lines 15-20, 43-50) (first financial institution can have HOPE software package as well other institutions due to deregulation in the banking and financial industry) (col 10: table 6, 11) (collateral agreements, second institution as mortgage company) (see col 4, lines 22-35, col 9, lines 62-67, col 8, lines 8-13., col 13, lines 45-56, col 15, lines 21-32, col 7: table 5, II(Visa, etc as servicing cash flow being a third party facility, (service student loans by third party facility), lines 59 to col 8, line 7).

Response to Arguments

Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that Atkins does not disclose a second financial institution separate from the first institution, in the instant specification, there is no antecedent basis for this aspect of the claims. The detailed description is directed to different accounts but there is no differentiation for separate financial institutions.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant did not traverse the examiner's assertion of official notice; therefore, Examiner takes the common knowledge or well-known in the art statement to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Campen whose telephone number is (571) 272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kelly S Campen